

08 JUL 2008



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In re Application of	:	
MAIO et al.	:	
Application No.: 10/577,929	:	DECISION
PCT No.: PCT/EP2004/052674	:	
Int. Filing Date: 27 October 2004	:	
Priority Date: 30 October 2003	:	
Attorney Docket No.: 288921US0X PCT	:	
For: PROCESS AND APPARATUS FOR COOLING	:	
AND ATOMIZING LIQUID OR PASTY-LIKE	:	
SUBSTANCES	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 08 April 2008 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** as **MOOT**.

**BACKGROUND**

On 27 October 2004, applicants filed international application PCT/EP2004/052674, which designated the United States and claimed a priority date of 30 October 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 02 June 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 01 May 2006 (30 April 2006 being a Sunday).

On 01 May 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an Application Data Sheet (ADS), and a copy of a declaration of inventors under PCT Rule 4.17(iv) filed in the international application.

On 03 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/909) according to the application a 35 U.S.C. 371 date of 01 May 2006.

On 08 May 2008, applicants filed the instant petition under 37 CFR 1.47(a). The petition was accompanied by five declarations of inventors.

### DISCUSSION

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The ADS filed 01 May 2006 and the declarations filed 08 April 2008 do not list the inventorship set forth in the international application. The ADS and declarations identify two additional inventors not listed in the international application--Leonardo GALLI and Mauro MENEGOLI. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that an inventor has been added does not appear in the file. Nor is there any other indication that a PCT Rule 92<sup>bis</sup> change has been made in the above-identified international application. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application. The ADS filed 01 May 2006 is in error, the declarations filed 08 April 2008 do not list the proper inventorship, **and the petition under 37 CFR 1.47(a) is moot** since the alleged non-signing inventor, Mauro MENEGOLI, is not an inventor in the instant application.

#### If Correct Inventorship is Four Inventors

If the correct inventorship is that set forth in the international application, it can be corrected by correcting the ADS with submission of a request for correction and a supplemental application data sheet. See MPEP 601.05, *Supplemental ADS submissions*. The two inventors not listed in the international application would need to be deleted as inventors.

#### If Correct Inventorship is Six Inventors

If the correct inventorship is that set forth in the ADS filed 01 May 2006 and the declarations of inventors filed 08 April 2008, then a petition under 37 CFR 1.497(d) is required. If applicants file such a petition, applicants should note that a statement from each person being added as an inventor is required. In this case, a statement would be required from the person the petition under 37 CFR 1.47(a) alleges is a non-signing inventor. Although the requirements of 37 CFR 1.497(d) may be waived upon the filing of a request and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.497(d)) to permit the filing of a statement by less than all the parties required to submit a statement, **these occasions are rare and such a waiver will not be considered unless the facts of record unequivocally support the correction sought**. As 37 CFR 1.497(d) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought. *Cf.*, MPEP 201.03, II, A, (set forth in part below).

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.497(d) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.497(d) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120). *Cf.*, MPEP 201.03, II, A, (set forth in part below).

MPEP 201.03, II, A states in part:

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a petition and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Applicants are required to file a proper response within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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